

**REMARKS**

Claims 1, 2, 4, 5, 7-13, 15, 16, and 30-36 were pending in this application.

Claims 1, 2, 4, 5, 7-13, 15, 16, and 30-36 have been rejected.

Claims 1, 4, 10, 12, 15, 30, and 34 have been amended as shown above.

Claims 1, 2, 4, 5, 7-13, 15, 16, and 30-36 remain pending in this application.

Reconsideration and full allowance of Claims 1, 2, 4, 5, 7-13, 15, 16, and 30-36 are respectfully requested.

**I. REJECTION UNDER 35 U.S.C. § 102**

The Office Action rejects Claims 1, 2, 4, 12, 13, and 15 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,226,997 to Vallier ("*Vallier*"). The Applicants respectfully traverse this rejection.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

Claims 1 and 12 have been amended to recite "vacuum holding" at least one "pre-formed film of compliant material" against at least one "mold cavity surface" of a "transfer mold." *Vallier* lacks any mention of "vacuum holding" an upper liner 12 against a surface of a first mold

half 20 or “vacuum holding” a lower liner 14 against a surface of a second mold half 25. In fact, *Vallier* lacks any mention of any mechanism for holding the liners 12, 14 against surfaces of the mold halves 20, 25.

*Vallier* does recite forming the upper liner 12 and the lower liner 14 using “vacuum forming.” (*Col. 4, Lines 23-37*). However, this portion of *Vallier* recites how the liners 12, 14 are initially shaped, not how the liners 12, 14 are used after they have been shaped. In other words, this portion of *Vallier* recites how a non-formed liner is shaped using vacuum holding. As a result, *Vallier* fails to anticipate vacuum holding at least one “pre-formed” film of compliant material against at least one “mold cavity surface” of a “transfer mold” as recited in Claims 1 and 12 (and their dependent claims).

*Vallier* also recites “evacuating” air from within the mold. However, *Vallier* expressly recites that air is evacuated from a “chamber” formed between the upper liner 12 and the lower liner 14. (*Col. 2, Lines 61-68; Col. 6, Lines 26-30*). If anything, the creation of a vacuum in a chamber between the liners 12, 14 would tend to pull the liners 12, 14 away from the mold halves 20, 25. As a result, *Vallier* fails to anticipate “vacuum holding” at least one “pre-formed film of compliant material” against at least one “mold cavity surface” of a “transfer mold” as recited in Claims 1 and 12 (and their dependent claims).

Accordingly, the Applicants respectfully request withdrawal of the § 102 rejection and full allowance of Claims 1, 2, 4, 12, 13, and 15.

## II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 5, 7-11, 16, and 30-36 under 35 U.S.C. § 103(a) as being unpatentable over *Vallier* in view of U.S. Statutory Invention Registration No. H1654 to Rounds (“*Rounds*”). The Applicants respectfully traverse this rejection.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or

motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*MPEP* § 2142).

Claims 5, 30, and 31 depend from Claim 1. Claims 16 and 34-36 depend from Claim 12. As described above in Section I, Claims 1 and 12 are patentable. As a result, Claims 5, 16, 30, 31, and 34-36 are patentable due to their dependence from allowable base claims.

Claims 7, 30, and 34 recite "pre-forming" multiple "portions" of a tape or film to at least approximately conform a shape of each portion to a mold cavity surface of a transfer mold. *Vallier* simply recites forming individual liners. *Vallier* lacks any mention of "pre-forming" multiple "portions" of a single liner to at least approximately conform each portion to a shape of a mold cavity surface.

*Rounds* simply recites a process similar to the process described in the "Background" of the Applicants' specification. A supply of liner film (such as a "reel-to-reel supply") is applied to the surfaces of a mold. (*Col. 2, Lines 39-41 and 56-57*). The film may be applied to the mold using techniques such as vacuum forming. (*Col. 2, Lines 39-41*). *Rounds* lacks any mention of "pre-forming" multiple portions of the liner film to at least approximately conform a shape of each portion to a mold cavity surface. In fact, *Rounds* lacks any mention of "pre-forming" the liner film at all.

For these reasons, the proposed *Vallier-Rounds* combination fails to disclose, teach, or suggest all elements of Claims 7, 30, and 34 (and their dependent claims).

Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 5, 7-11, 16, and 30-36.

### III. CONCLUSION

The Applicants respectfully assert that all pending claims in this application are in condition for allowance and respectfully request full allowance of the claims.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Applicants have included the appropriate fee to cover the cost of a Request for Continued Examination. The Applicants have also included the appropriate fee to cover the cost of a one (1) month extension of time. The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any additional extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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Date: Feb 22, 2005



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